

Amendment and Response

Serial No.: 10/702,369

Confirmation No.: 8480

Filed: 6 November 2003

For: BEAK TREATMENT WITH TONGUE PROTECTION

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Remarks

The Office Action mailed 14 February 2005 has been received and reviewed. Claim 6 has been amended, leaving claims 1-18 pending. Reconsideration and withdrawal of the rejections are respectfully requested.

Allowable Claims

Applicant notes that claims 11-18 have been indicated as allowable, and claims 6-10 would be allowable if rewritten in independent form. Applicant has amended claim 6 to incorporate the recitations of its base claim (i.e., claim 1). As a result, Applicant submits that claims 6-10 and claims 11-18 are all in condition for allowance.

The 35 U.S.C. §112, Second Paragraph, Rejection

Claim 1 was rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the Examiner alleges that there is insufficient antecedent basis for the limitation "second major surface" recited in claim 1. Applicant respectfully disagrees.

Claim 1 does recite "first and second major sides" in line 3 (before the first occurrence of "the second major surface"). As a result, Applicant respectfully submits that "the second major surface" recited in claim 1 does have proper antecedent basis within claim 1.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 1 under § 112, second paragraph are respectfully requested.

The 35 U.S.C. §102 Rejection

Claims 1-5 were rejected under 35 U.S.C. §102(b) as being anticipated by Gorans et al. (U.S. Patent No. 5,651,731). This rejection is respectfully traversed.

In support of this rejection it is asserted that Gorans et al. teaches "pressing inward on the throat of the bird (pressure is applied to the throat and towards the tongue by the first side of the device as the bird handler presses the birds head and beak into the aperture)." Applicant notes,

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however, that no support is identified in Gorans et al. for this assertion, nor does Gorans teach the actions asserted above. As a result, Applicant assumes that the basis for this rejection is inherency, i.e., that Gorans et al. inherently teaches the actions asserted in the Office Action.

Applicant notes, however, that the requirements for an anticipation rejection based on inherency have not been met. More specifically, it has not been shown that the actions recited in the above-quoted assertion must necessarily occur when practicing the methods taught in Gorans et al. *See, e.g.*, MPEP § 2112(IV), pp. 2100-54 to 2100-55, 8th Ed. (Rev. 2, May 2004).

Whether or not such actions might occur is not sufficient to support an anticipation rejection.

In addition, it is asserted in the Office Action that Gorans et al. teaches "directing the energy at the second side, wherein the energy is incident on the lower beak while pressing on the throat (fig. 10)." Applicant respectfully disagrees.

Gorans et al. teaches only treatment of the upper beak and all references to energy delivery recite delivery of the energy to the upper beak. As a result, the above-quoted assertion with respect to energy delivery to the lower beak is not supported by the reference. In fact, Gorans et al. notes that one advantage of the disclosed process is "that the invention allows the bird to retain its lower beak which helps in eating and drinking." Gorans et al. Col. 2, lines 2-4.

With respect to dependent claims 2-5, Applicant submits that Gorans et al. fails to teach any of the actions recited in these claims, all of which relate to the act of pressing inward on the throat of the bird as recited in claim 1.

For at least the above reasons, Applicant submits that claims 1-5 are patentable over Gorans et al. in view of 35 U.S.C. § 102. Reconsideration and withdrawal of this rejection are, therefore, respectfully requested.

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Summary

It is respectfully submitted that the pending claims 1-18 are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicant's Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for

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14 June 2005
DateBy: 
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Direct Dial (612) 305-1218**CERTIFICATE UNDER 37 CFR §1.8:**

The undersigned hereby certifies that the Transmittal Letter and the paper(s), as described hereinabove, are being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 14th day of June, 2005, at 12:40 pm (Central Time).

By: Sue Dombroske
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